

In The United States Patent And Trademark Office

Applicant:	Wayne Boga et al.	Date:	June 8, 2009
Date Filed:	February 6, 2004	Docket No.:	METSO-19
App. No.:	10/774,084	Art Unit:	1794
For:	Seal Strip for a Suction Roll and a Method for Manufacturing It	Examiner:	L. Ferguson

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**Comments on Reasons for Allowance**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Allowance dated May 29, 2009, please enter the following reasons for allowance. The Commissioner is hereby authorized to charge any additional fees that may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 50-2663.

The examiner's remarks appear to indicate that the claims are limited to a suction roll seal strip having a cross-section of 1.9 x 4.8 cm with a radius of less than 1.5 m. This is in direct contrast to the claim language "the suction roll seal strip comprising: a section of material selected to allow a seal strip with a cross-section of 1.9 cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm", where the cross-section and radius are used to define the flexibility of the material selected, not the shape of the claimed suction roll seal strip. Applicant has consistently throughout the file record made the meaning of the claim language clear, as indicated in the following excerpts from the file record:

**Appeal Brief Renewed (and corrected)** filed February 23, 2009:

**Independent claims 15 and 30** are to a suction roll seal strip  
(abstract, page 14, line 1) constructed of a material which is

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sufficiently flexible (page 5, lines 24–25) so that a seal strip with a cross-section of 1.9 cm by 4.8 cm (page 10, lines 1–10) could be bent into a reel with a radius of less than 150 cm, i.e., <1.5 m (page 5, lines 22–23). [page 2, lines 3-6, emphasis in original]

**Claims 17, 26, and 31–34 are argued separately** and include in addition to nitrile rubber, graphite, and wax, the limitation that the suction roll seal strip be sufficiently flexible (page 5, lines 24–25) so that a seal strip with a cross-section of 1.9 cm by 4.8 cm (page 10, lines 1–10) could be bent into a reel with a radius of less than 150 cm i.e., <1.5 m (page 5, lines 22–23). [page 3, lines 8-12, emphasis in original]

Claims 15, 30 have but two elements: a suction roll seal set forth in the preamble and the claim body, and *a material of a claimed level of flexibility* set forth in the body of the claim. Reason and justice breaks down if the examiner is allowed in subsequent Office actions, especially subsequent to an Appeal brief being filed, to alternate between an assertion that the preamble has no weight (first action, action reopening prosecution), and that the specified level of flexibility has little or no patentable weight (Final Action). [page 8, lines 6-11, emphasis supplied]

However, claims 17, 26, and 31–32 combine the addition of wax to the material from which the suction roll seal strip is formed, with the requirement that the seal material allow a seal strip with a cross-section of 1.9 cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm or 130 cm. Thus claims 17, 26, and 31–32 require more than that wax be present, but that the *material incorporating the wax achieve a certain level of flexibility*. [page 11, lines 13-18, emphasis supplied]

This simply doesn't provide rationally articulated reasons for why a suction roll seal strip, of the claimed material (including wax), and *of the claimed flexibility* would be obvious to a person of ordinary skill in the art. [page 12, lines 1-3, emphasis in original]

Claims 33–34 combine the addition of a wax meeting

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limitations of temperature or composition with the requirement that *the seal material allow a seal strip with a cross-section of 1.9 cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm*. Thus claims 33–34 require more than that a wax meeting the limitations of temperature or composition be present, but that the *material incorporating the wax achieve a certain level of flexibility* in a suction roll seal strip. [page 13, lines 24 through page 14, line 2 emphasis supplied]

Further during prosecution, the examiner described claim language “the suction roll seal strip comprising: a section of material selected to allow a seal strip with a cross-section of 1.9 cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm” as functional:

In claims 15, 17 and 26, the phrases, "to allow a seal with a cross-section of 1.9cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm", "permits the seal strip to be bent onto a reel" and "can be rolled onto a reel with a radius of less than 1.5m" respectively constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ will performing a function is not a positive limitation but only requires the ability to so perform.[Office action mailed May 4, 2007, page 4, lines 1-7]

To which the applicant responded in the first Appeal Brief filed on March 17, 2008, by clearly pointing out the functional nature of limitation, and the permissibility of such functional claiming as set forth in MPEP 2173.05(g) Functional Limitations. Applicant stated:

Applicants’ claim limitation “*a material selected to allow a seal strip with a cross-section of 1.9 cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm, said material defining the suction roll seal strip,*” is a limitation to a suction roll seal strip, limiting the seal strip to one formed of a material which is sufficiently flexible that a seal strip with a section of 1.9 cm by 4.8 cm can be bent into a reel with a radius of less than 150 cm. If applicants had specified the durometer (hardness) of the material of the suction roll seal strip it would clearly be a limitation to the claims, but applicants are free to choose how they define their invention. Here applicants choose to claim the invention in a way which captures the benefit applicants disclose

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of lowering shipping cost of the suction roll seal strip by  
shipping it coiled on a reel with a radius of less than 150 cm.  
[Appeal Brief filed March 17, 2008, page 5, lines 24 through  
page 6, line 2, emphasis in original]

Respectfully submitted,



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